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In re Application of :
Alexander Steinbuchel et al :
Serial No.: 09/750,986 : PETITION DECISION
Filed: December 28, 2000 :
Attorney Docket No.: Eisenfuhr-9998.2 :

This is in response to the petition under 37 CFR 1.144, filed December 1, 2004, requesting withdrawal of an improper restriction requirement.

BACKGROUND

A review of the file history shows that this application was filed under 35 U.S.C. 111 as a Divisional of SN 08/976,063, and contained claims 1-13. In a first Office action, mailed May 4, 2004, the examiner set forth a restriction requirement, as follows:

Group I – Claims 1-2, drawn to eugenol hydrogenase, in part;
Group II – Claims 1-2, drawn to coniferyl alcohol dehydrogenase, in part;
Group III – Claims 1-2, drawn to coniferylaldehyde dehydrogenase, in part;
Group IV – Claims 1-2, drawn to ferulic acid deacylase, in part;
Group V – Claims 1-2, drawn to vanillin dehydrogenase, in part;
Group VI – Claims 3-7, drawn to a polynucleotide encoding eugenol hydrogenase;
Group VII – Claims 3-7, drawn to a polynucleotide encoding coniferyl alcohol dehydrogenase;
Group VIII – Claims 3-7, drawn to a polynucleotide encoding coniferylaldehyde dehydrogenase;
Group IX – Claims 3-7, drawn to a polynucleotide encoding ferulic acid deacylase;
Group X – Claims 3-7, drawn to a polynucleotide encoding vanillin dehydrogenase;
Group XI – Claim 8, drawn to making coniferyl alcohol, in part;
Group XII – Claim 8, drawn to making coniferylaldehyde, in part;
Group XIII – Claim 8, drawn to making ferulic acid, in part;
Group XIV – Claim 8, drawn to making vanillin, in part;
Group XV – Claim 8, drawn to making vanillic acid, in part;
Group XVI – Claim 9, drawn to making coniferyl alcohol using eugenol hydrogenase;

Group XVII – Claim 10, drawn to making coniferylaldehyde using coniferyl alcohol dehydrogenase;

Group XVIII – Claim 11, drawn to making ferulic acid using coniferylaldehyde dehydrogenase;

Group XIX – Claim 12, drawn to making vanillin using ferulic acid deacylase; and

Group XX – Claim 13, drawn to making vanillic acid using vanillin dehydrogenase.

The examiner presented appropriate arguments as to why the Groups were directed to patentably distinct inventions and further indicated possible future rejoinder of method claims with elected product claims if product claims are determined to be allowable.

Applicants replied on June 1, 2004, and elected Group IV, with traverse. Applicants also amended most of the claims.

The examiner mailed applicants a new Office action on July 2, 2004, responding to the traversal of the restriction requirement and making the requirement Final. The examiner also rejected the elected claims under 35 U.S.C. 112, first and second paragraphs and under 35 U.S.C. 102(b) as anticipated by Priefert et al or Jaeger et al and for obvious double patenting over the parent application.

Applicants replied on December 1, 2004, by further amending the claims and responding to the various rejections appropriately. Applicants also filed this petition.

DISCUSSION

Applicants first argue that this is a Divisional application and that in the parent application only an election of species was required. This argument is not persuasive. While the Office generally strives for consistency in prosecution from application to application, each application must be evaluated on its own merits. Although the examiner in the previous application made only an election of species requirement, it is noted that there were two different requirements for different claim sets thus implying that a restriction was also being set forth. The examiner in this application upon review of the claims determined that a restriction was proper and set such forth. That it differs from the previous examiner's requirement is not dispositive of error.

Applicants argue that the examiner first required an election from among the 20 groups set forth above and then an election of species within the elected group. A review of the requirement set forth in the Office action of May 4, 2004, finds no election of species requirement set forth. Applicants also argue that there is no burden on the examiner to search and examine all of the groups listed above. However, the examiner set forth arguments indicating that the inventions are separate and distinct based on classification and other criteria thus establishing a potential burden on the Office. It is further noted that prosecution may also involve searching of specific sequences, although none are set forth in the claims as filed. As each sequence is considered a separate compound the searching of multiple sequences provides further evidence of burden on the Office in contravention to applicants' arguments.

A review of the requirement set forth by the examiner shows that it is not fundamentally incorrect. Claim 1, as filed, is a linking claim encompassing the different enzymes of claim 2. As such the election of one of the enzymes of claim 2 would require examination of linking claim 1 also. The first five Groups, which all include claim 1, in essence provide this. The second set of five Groups (VI-X) are linked by claim 3, but are separate and distinct inventions based on the DNA which codes for enzyme elected. An election of one of these groups would also include consideration of linking claim 3. Claim 8 is also a linking claim encompassing claims 9-13 (Groups XVI-XX). As such Groups XI-XV and Groups XVI-XX should be joined with claim 8 being examined with whichever of Groups XI-XV would be elected. The restriction requirement is hereby so modified. The process of claims 8-13 – for making various products - is different from the process of claim 7 – for making a microorganism and properly divisible therefrom.

Rejoinder of the method claims of Groups XI-XV (as modified) in view of the election of a product claim Group is deferred until such time as an allowable product claim is identified.

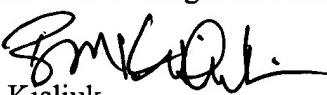
It is noted that applicants' amendment filed concurrently with the petition cancels claims directed to many of the above identified Groups, but also now inserts SEQ ID NOs.

DECISION

The petition with respect to the original restriction requirement is **GRANTED-IN-PART** as noted above (Groups XVI-XX are joined with their counterpart Groups XI-XV). Applicants' election remains in effect.

The application will be forwarded to the examiner for further consideration of the claims, as amended, and potential rejoinder of method claims should the elected product claims be found allowable.

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number, 571-273-8300


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